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48

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In re Application of:

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|---|---|---------------------------|
| AMATO, Tony | : | DECISION ON REQUEST UNDER |
| U.S. Application No.: 10/534,124 | : | 37 CFR 1.497(d) |
| PCT No.: PCT/GB2003/004826 | : | |
| International Filing Date: 07 November 2003 | : | |
| Priority Date: 08 November 2002 | : | |
| Attorney's Docket No.: 745691-39 | : | |
| For: ULTRASOUND APPARATUS AND | : | |
| THE MANUFACTURE THEREOF | : | |

This decision is issued in response to applicant's 18 November 2005 response to the Notification Of Missing Requirements (Form PCT/DO/EO/905) mailed 14 November 2005, treated herein as a request under 37 CFR 1.497(d) to correct the inventorship in the present application. Deposit Account No. 19-2380 will be charged the required processing fee.

BACKGROUND

On 07 November 2003, applicant filed international application PCT/GB2003/004826 which claimed a priority date of 08 November 2002 and which designated the United States. On 21 May 2004, a copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) by the International Bureau (IB). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 08 May 2005. The published international application identified a corporate applicant for all states other than the U.S., and a single applicant/inventor for the U.S., Tony AMATO.

On 06 May 2004, applicant filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 14 November 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration acceptable under 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months from the priority date were required.

On 18 November 2005, applicants filed the response to the Notification Of Missing Requirements considered herein. The response included the required surcharge payment and a declaration executed by two persons, both identified as inventors herein: Tony AMATO and

Michael John CRANE. The submission also included a "Statement Pursuant to 37 CFR 1.497(d)" executed by Michael John CRANE.

DISCUSSION

Where, as here, the filed declaration names additional inventors who were not identified on the international application, 37 CFR 1.497(d) requires applicant to submit: (1) a statement from each person being added as an inventor that any error in inventorship in the international application occurred without deceptive intent; (2) the processing fee; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the consignee (in the form required by 37 CFR 3.73(b)).

Applicant here has submitted the required statement by the added inventor, Michael John CRANE. Item (1) is therefore satisfied.

The 18 November 2005 submission includes the authorization to charge Deposit Account No. 19-2380 for required fees. Based on this authorization, Deposit Account No. 19-2380 will be charged the required \$130 processing fee. Item (2) is therefore satisfied.

Regarding item three, applicant has not submitted the assent of the assignee to the change of inventorship. No assignment has been recorded herein, but the Application Data Sheet (ADS) identifies Sonico Limited as the assignee. Before item (3) can be considered satisfied, applicant must provide the written consent of the assignee to the change of inventorship. Any such consent of the assignee must be accompanied by a proper statement under 37 CFR 3.73(b).

Based on the above, the present record does not satisfy all the requirements for correction of the inventorship under 37 CFR 1.497(d).

CONCLUSION

Applicant's request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

Tony AMATO remains the sole inventor of record herein. Accordingly, the declaration filed 18 November 2005, which identifies both Mr. AMATO and Mr. CRANE as inventors, is defective at present for failure to properly identify the inventors of record herein.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and must include the materials required to satisfy item (3) of a grantable request, as discussed above (i.e., the consent of the assignee in the form required by 37 CFR 3.73(b)).

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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